

REMARKS

I. Summary Of Office Action

Claims 1-86, 89-133, and 135-144 were pending in the above-identified patent application.

The Examiner rejected claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. patent 6,004,211 (hereinafter "Brenner") in view of Lappington et al. U.S. patent 5,734,413 (hereinafter "Lappington"). Claims 142-144 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of Lappington and further in view of "well known . . . set-top devices" (Office Action, page 5, line 21). Claims 89, 90, and 135-141 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of LaDue U.S. patent 5,999,808 (hereinafter "LaDue").

II. The Drawing Amendment Proposed In The February 26, 2003 Reply To Office Action

Applicants respectfully refer the Examiner to the February 26, 2003 Reply to Office Action, in which applicants proposed an amendment to FIG. 5 of the drawings. In the March 20, 2003 Office Action, the Examiner does not refer to the proposed drawing amendment. Accordingly, applicants respectfully request that the Examiner (1) consider the

proposed drawing amendment in the February 26, 2003 Reply to Office Action and (2) provide applicants with a decision regarding the proposed drawing amendment in the next communication.

III. The Rejection Of Claims 1-86 And
91-133 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-86 and 91-133 under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of Lappington. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 1, 44, and 91, is directed towards a method, system, and computer readable medium for submitting electronic wagers on races that are to be run to computer equipment over a communications network. At least one wireless portable computing device with a display is in two-way wireless communications with in-home user equipment. A user at the wireless portable computing device is provided with on-screen options on the display of the wireless portable computing device that allow the user to create a wager. The on-screen options are based, at least in part, on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment. The information is based, at least in part, on racing data

received by the in-home user equipment from the communications network. The user is allowed to wirelessly transmit the wager from the wireless portable computing device to the in-home user equipment over the wireless communications path when it is desired to submit the wager for processing.

Applicants respectfully submit that claims 1, 44, and 91 are allowable over Brenner in view of Lappington for at least the following reasons.

A. The Combination Of Brenner And The Wireless Handheld Device Of Lappington Does Not Show Or Suggest All Elements Of Applicants' Claims

The Examiner contends that the combination of Brenner with the wireless handheld device of Lappington would result in applicants' invention as defined by claims 1, 44, and 91. Contrary to the Examiner's contention, however, the combination of Brenner with the wireless handheld device of Lappington would fail to show or suggest applicants' improvements of (a) providing a user at a wireless portable computing device with on-screen options on the display of the wireless portable computing device, wherein the on-screen options are based at least in part on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment and

(b) allowing the user to wirelessly transmit the wager from the wireless portable computing device to the in-home user equipment over the wireless communications path when it is desired to submit the wager for processing, as defined by applicants' claims 1, 44, and 91.

Applicants agree with the Examiner that Brenner teaches "that any suitable wireless user interface device can be used" (Office Action, page 2, lines 20 and 21). However, the mere combination of Brenner with "any suitable wireless user interface" such as handheld 32 of Lappington would not result in transferring the wagering interfaces of Brenner onto handheld 32. In other words, by combining Brenner with handheld 32 of Lappington, the trivia game displayed on handheld 32 of Lappington would not be swapped for the wagering interfaces of Brenner. Rather, based on the teachings of Brenner, the combination of Brenner with "any suitable wireless user interface" such as that provided in Lappington would at best allow a user to interact with the menus on monitor 126 or monitor 378 of Brenner using handheld 32 of Lappington.

Accordingly, the combination of Brenner with handheld 32 of Lappington would fail to show or suggest applicants' improvement of providing a user at a wireless

portable computing device with on-screen options on the display of the wireless portable computing device that are based at least in part on information received over a wireless communications path between the wireless portable computing device. Since the combination fails to show or suggest providing the "on-screen options" of applicants' claims 1, 44, and 91, it follows that the combination also fails to show or suggest the improvement of allowing the user to wirelessly transmit a wager from the wireless portable computing device to the in-home user equipment, as defined by claims 1, 44, and 91.

B. The Examiner Failed To Provide A
 Sufficient Motivation For Transferring
 The Wagering Interfaces Of Brenner
 To Handheld 32 Of Lappington

As described hereinabove in the previous subsection, the combination of Brenner with handheld 32 of Lappington fails to show or suggest providing the wagering interfaces of Brenner on handheld 32 of Lappington. In the Office Action, however, it appears that the Examiner may be suggesting that it would have been obvious to do this. In particular, it appears that the Examiner is providing three different motivations for providing the wagering interfaces

of Brenner on handheld 32 of Lappington, which applicants respectfully traverse hereinbelow.

1. "Allow[ing] The Race To Be Displayed
On A Separate Display Continuously"
Is Not A Sufficient Motivation

The Examiner contends that "it would have been obvious to one skilled in the art at the time to display informational/wager choices on the PDA to allow the race to be displayed on a separate display continuously" (Office Action, page 3, lines 4-6). Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington because a user of the system of Brenner can place a wager while watching racing video at the same time: "[r]acing videos can be viewed while the user reviews odds and places bets" (Brenner, Abstract). Thus, because a user of the system of Brenner can view a race continuously while making wagering selections, the Examiner's motivation to provide racing video on a separate display is insufficient.

2. "View[ing] Multiple Concurrent
Events Without Losing Scores" Is
Not A Sufficient Motivation

The Examiner contends that "it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp for the purposes taught . . . by Lapp such as view multiple concurrent events without losing scores" (Office Action, page 3, lines 6-9). Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington for at least the following reason.

The "interactive games" of Lappington, which are basically trivia games that a television viewer can play along with while watching a television program, cannot be analogized to the wager creation process of Brenner. In Lappington, "where a viewer returns to a program that was previously watched, the interactive game continues, leaving out only the part [of the interactive game] that was missed" (column 4, lines 1-3). Thus, in Lappington, when a viewer changes channels to watch another program, the viewer misses certain trivia questions, although a total score is maintained by the handheld device. Analogizing this to the wager creation process of Brenner would result in skipping certain steps in the wager creation process (e.g., selecting a track, selecting a horse, etc), thereby rendering the wager creation process incomplete. Furthermore, there is no analogous "score" to be kept in Brenner.

Thus, the purpose of Lappington to "view multiple concurrent events without losing scores," as set forth by the Examiner, has no relevance to Brenner. Accordingly, the motivation provided by the Examiner is insufficient.

3. "Plac[ing] Multiple Concurrent
Bets On Different Races" Is
Not A Sufficient Motivation

The Examiner contends that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp [to allow] one to place multiple concurrent bets on different races, releasing the constraints of betting only on a single game at any one time.

(Office Action, page 3, lines 6-11) Applicants respectfully submit that this is not a sufficient motivation to provide the wagering interfaces of Brenner on handheld 32 of Lappington for at least the following reason.

To modify Brenner to allow for the "concurrent" creation of wagers, it would be reasonable to expect one of skill in the art to modify the software of Brenner that provides the wagering interfaces. It would not be reasonable to expect one of skill in the art to first modify Brenner by putting the wagering interfaces on a separate device (e.g., handheld 32 of Lappington), and then modify the software to allow for concurrent creation of wagers.

Thus, for at least these reasons, claims 1, 44, and 91 are allowable over Brenner in view of Lappington. Therefore, applicants request that the rejection of claims 1, 44, and 91 based on Brenner in view of Lappington be withdrawn. In addition, claims 2-43, 45-86, and 92-133 are allowable at least because independent claim 1, from which claims 2-43 depend, independent claim 44, from which claims 45-86 depend, and independent claim 91, from which claims 92-133 depend, are allowable. Accordingly, applicants request that the rejection of claims 2-43, 45-86, and 92-133 be withdrawn.

IV. The Rejection Of Claims 142-144
Under 35 U.S.C. § 103(a)

The Examiner rejected claims 142-144 under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of Lappington and further in view of "well known . . . set-top devices" (Office Action, page 5, line 21). The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 142-144, is directed towards a method, system, and

* For the record, applicants' respectfully disagree with the Examiner's contention that "Brenner et al. does not teach that the user terminal is a set-top box" (Office Action, page 4, lines 1 and 2). Applicants submit that Brenner does in fact disclose that the user terminal may include a set-top box (see, for example, column 22, lines 16-23 of Brenner).

computer readable medium for submitting electronic wagers on races that are to be run to computer equipment over a communications network. At least one wireless portable computing device with a display is in two-way wireless communications with a television set-top box.

Applicants' claims 142-144 are allowable over Brenner in view of Lappington for at least the reasons provided hereinabove with respect to claims 1, 44, and 91. Furthermore, the Examiner's reliance on "well known . . . set-top devices" does not overcome the fact that the combination of Brenner with handheld 32 of Lappington would not result in the inclusion of the wagering interfaces of Brenner on handheld 32. Accordingly, applicants request that the rejection of claims 142-144 based on Brenner in view of Lappington and further in view of "well known . . . set-top devices" be withdrawn.

V. The Rejection Of Claims 89, 90, And
 135-141 Over Brenner In View Of
 LaDue Under 35 U.S.C. § 103(a)

The Examiner rejected claims 89, 90, and 135-141 under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of LaDue. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by claims 89, 90, and 135, is directed towards a method, system, and computer readable medium for wirelessly submitting electronic wagers to computer equipment. The user is allowed to create a wager with wireless user equipment and is allowed to transmit that wager from the wireless user equipment to a communications network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment. The wager is received at the computer equipment for processing from communications equipment at the racetrack over the communications network.

The Examiner contends that the combination of Brenner and LaDue would result in applicants' invention as defined by claims 89, 90, and 135. Contrary to the Examiner's contention, however, the combination of Brenner and LaDue fails to teach applicants' improvement of allowing a user to transmit a wager from wireless user equipment to a communications network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment, as defined by applicants' claims 89, 90, and 135.

In particular, neither Brenner nor LaDue show or suggest including communications equipment at a racetrack that communicates wirelessly with wireless user equipment.

To overcome this admitted gap in the cited art, the Examiner contends that the inclusion of communications equipment at a racetrack that communicates wirelessly with wireless user equipment "is obvious, with respect to the necessity of having the equipment in the first place. The communication equipment would already be in place for the existing wagering system" (Office Action, page 9, lines 13 and 14). However, the "existing wagering system" of Brenner does not include communications equipment at a racetrack that communicates wirelessly with wireless user equipment. Furthermore, the interactive wagering system of Brenner is fully functional without such wireless communications equipment at the racetrack, and therefore applicants respectfully disagree that there is a "necessity of having the equipment [at the racetrack] in the first place."

Accordingly, for at least these reasons, claims 89, 90, and 135 are allowable over Brenner in view of LaDue. Accordingly, applicants request that the rejection of claims 89, 90, and 135 based on Brenner in view of LaDue be withdrawn.

VI. Conclusion

The foregoing demonstrates that claims 1-86, 89-133, and 135-144 are patentable. This application is

therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



Laura A. Sheridan
Registration No. 48,446
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax : (212) 596-9090